

REMARKS

Claims 10-29 are pending. By this Amendment, the Abstract and claims 10, 13, 15-17, 20, 23, and 25-27 are amended, and claims 12 and 22 are canceled. Claims 13 and 23 are amended to correct their dependency following cancellation of claims 12 and 22 respectively. Claims 15-17 and 25-27 are amended to correct antecedent basis following amendment to claims 10 and 20, respectively. No new matter is introduced. Reconsideration and issuance of a Notice of Allowance is respectfully requested.

On page 2 the Office Action asserts that the Applicant is not entitled to priority based on U.S. Application Serial No. 07/991,074 filed December 9, 1992. Instead, the Office Action asserts that the priority date for the application is November 7, 1994.

Applicant has carefully reviewed Application Serial No. 07/991,074, and has amended claims 10 and 20 such that these independent claims recite elements clearly disclosed in the '074 application. Accordingly, Applicant asserts that the correct priority date for the instant application is that of Application Serial No. 07/991,074, that is, December 9, 1992. Applicant respectfully requests reconsideration of the assigned priority date. To assist the Examiner, enclosed herein are examples of pages from the '074 application wherein the recited subject matter is disclosed.

On page 2 the Office Action objects to the Abstract. The Abstract is hereby amended as shown in the attached replacement page. Withdrawal of the objection of the Abstract is respectfully requested.

On page 3 the Office Action rejects claims 10-12 and 20-22 under 35 U.S.C. §102(e) over U.S. Patent 5,604,824 to *Chui et al.* (hereafter *Chui*). This rejection is respectfully traversed.

Independent claims 10 and 20 are amended such that they recite features clearly disclosed in the earliest cited application, that is, Application Serial No. 07/991,074. *Chui* is not prior art to this application. Accordingly, *Chui* is not prior art to claims 10 and 20 as amended. Therefore, claims 10 and 20 are patentable.

Claims 12 and 22 are canceled, and the rejection of these claims is moot. Claims 11 and 21 depend, respectively, from patentable claims 10 and 20, and for this reason and the additional features they recite, claims 11 and 21 are also patentable. Withdrawal of the rejection of claims 10-12 and 20-22 under 35 U.S.C. §102(e) is respectfully requested.

On page 4 the Office Action rejects claims 14-19 and 24-29 under 35 U.S.C. §103(a) over *Chui* in view of U.S. Patent 5,465,213 to *Ross* (hereafter *Ross*). This rejection is respectfully traversed.

The Office Action asserts that *Chui* teaches a network that communicates with a viewer at a remote location, but admits that *Chui* does not teach the steps of grouping text material by titles of the corresponding electronic books, permitting subscribers to purchase the electronic books via the viewers, and portable viewers that include a menu on the viewers to provide indications of electronic books. However, the Office Action asserts that *Ross* teaches these steps, and that it would have been obvious to one of ordinary skill in the art to incorporate the teachings of *Ross* and the apparatus of *Chui* to produce the inventions as recited in claims 14-19 and 24-29.

Chui is directed to an apparatus and a corresponding method for performing compression and decompression of documents. In *Chui*'s system, documents are provided from a variety of sources.

Chui describes a specific procedure for digitizing and then compressing these documents. However, *Chui* does not disclose or suggest providing electronic books to subscribers using small portable viewers.

Ross is directed to a computer-based book manufacturing, distribution, and retailing system for high speed production of a single copy of a book. The text and graphical material comprising one of *Ross*'s books is stored in electronic format and the stored books can be previewed using *Ross*'s customer console 36. As shown in Figures 2 and 3, the customer console 36 is a large, bulky object having a touch screen panel at a computer to access the database of digital text and video. As such, *Ross* does nothing to cure the defects in *Chui* with respect to distribution of electronic books to subscribers using small, portable viewers. More importantly, *Ross* is specifically directed away from providing electronic books to subscribers in a compressed video format using small portable viewers. A simple reading of the first sentence of *Ross*'s Abstract would lead even the most untrained observer to note that what is produced is not an electronic book, but instead a paper version of an electronically stored file. Simply put, *Ross* produces paper books for distribution to users and the invention as recited in claims 10 and 20 provides electronic books for distribution to users using small portable viewers. *Ross* elaborates at column 7, line 65 through column 8, line 48, wherein a product delivery system is disclosed in which, after a customer purchases a desired book, a clerk readies a printer 26, a microcomputer 18, a printer/plotter 28, and other components to produce a paper version of a book. The book's printed pages are cut with paper cutter 52 to achieve the correct size, placed in jogger table 50 to achieve proper paper alignment, and bound using thermal binder 54 into a hard copy of the book. Thus, *Ross*'s system does not

disclose or suggest providing electronic books to subscribers using any component, let alone a small portable viewer.

The Office Action also asserts, with respect to claims 14 and 24, that *Ross* discloses grouping electronic books by title. To support this proposition, the Office Action points to Figure 5 of *Ross*. All that Figure 5 shows is a format for an electronic file that describes the electronic book. That is, *Ross*'s system uses an attributes description and a book contents description, both of which are stored as separate files and associated with each of *Ross*'s electronic files. However, there is nothing in *Ross* that suggests that any books or electronic files are grouped by title. The mere fact that the book attribute description includes the title of the book can hardly be used for the proposition that *Ross*'s books are grouped by title.

In contrast to *Chui* and *Ross*, individually, and in combination, claim 14 recites grouping text material by titles of corresponding electronic books, claim 15 recites providing electronic books electronically to the small portable viewers, claim 16 recites permitting subscribers to purchase electronic books via the small portable viewers, claim 17 recites displaying a menu on the small portable viewers, and claims 18 and 19 recite features associated with menus for purchasing electronic books. Claims 24-29 recite features similar to those recited in claims 14-19. As discussed above, *Chui* and *Ross*, individually, and in combination, do not disclose a single one of these features. For this reason alone, claims 14-19 and 24-29 are patentable. In addition, claims 14-19 depend from patentable claim 10, and claims 24-29 depend from patentable claim 20. For this additional reason, claims 14-19 and 24-29 are patentable. Withdrawal of the rejection of claims 14-19 and 24-29 under 35 U.S.C. §103(a) is respectfully requested.

On page 6 the Office Action rejects claims 13 and 23 under 35 U.S.C. §103(a) over *Chui* in view of U.S. Patent 5,528,281 to *Grady et al.* (hereafter *Grady*). This rejection is respectfully traversed.

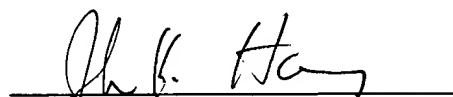
Claims 13 and 23 recite the converting step of respective claims 10 and 20 to include converting textual material into a format according to the MPEG standard. Use of the MPEG standard is clearly disclosed in Application Serial No. 07/991,074, filed on December 9, 1992. Accordingly, claims 13 and 23 should have a priority date of December 9, 1992. As such, *Chui* and *Grady* are not prior art to claims 13 and 23, and these claims are patentable. Withdrawal of the rejection of claims 13 and 23 under 35 U.S.C. §103(a) is respectfully requested.

In view of the above remarks, Applicant respectfully submits that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

Date: May 12, 2005



John K. Harrop
Registration No. 41,817
Andrews Kurth LLP
1701 Pennsylvania Ave, N.W.
Suite 300
Washington, DC 20006
Tel. (202) 662-3050
Fax (202) 662-2739

Attachments: Pages 30 and 56 from Specification of U.S. Application No. 07/991,074

receiver. Other types of compression are known to those skilled in the art, including, for example, discrete cosine transform ("DCT").

Several standard digital formats representing both digitizing standards and compression standards have been developed. For example, JPEG (joint photographic experts group) is a standard for single picture digitization. Motion picture digitization may be represented by standards such as MPEG or MPEG2 (motion picture engineering group specification). Other proprietary standards have been developed in addition to these. Although MPEG and MPEG2 for motion pictures are preferred in the present invention, any reliable digital format with compression may be used with the present invention.

Various hybrids of the above compression techniques have been developed by several companies including AT&T, Compression Labs, Inc., General Instrument, Scientific-Atlanta, Philips, and Zenith. As is known by those skilled in the art, any of the compression techniques developed by these companies, and other known techniques, may be used with the present invention.

Figure 3a shows effective allocation of 750 mHz of bandwidth for television programming. In Figure 3a bandwidth is allocated for both analog and digitally compressed signals. In the preferred embodiment, the bandwidth is divided so that each category of program receives a portion of the bandwidth. These categories correspond with major menus of the user interface software. The representative categories shown in figure 3a include: (1) high definition TV made possible through the use of compression technology, (2) A La Carte Channel category

would be used for digital radio usage in a separate room from that of the television. The upgrade has a separate tuner, decompressor, and visual display. In the preferred embodiment a second remote control (scaled down version) is provided to access the audio system.

The Level E hardware upgrade allows the subscriber to download large volumes of information from the operations center or cable headend 208. The Level E hardware upgrade will enable subscribers to download data such as books to local storage. Primarily the Level E hardware upgrade is additional local storage via hard disk, floppy, optical disk, magnetic cartridge etc. Preferably a small portable reader called "EveryBook™" is also provided with the upgrade to enable downloaded text to be read without the use of a TV.

The downloadable information may be text or video supplied by the operations center or cable headend 208. With this upgrade, books may be downloaded and read anywhere with the portable reader. Using this upgrade video may be downloaded and stored in compressed form for later decompression. The video would be decompressed only at the time of viewing. Important text that the public desires immediate access may be made available through this system. Text such as the President's speech, a new law, or a recent abortion decision rendered by the Supreme Court may be made immediately available.

Using a more sophisticated port, especially the SCSI port, multiple hardware upgrade units may be connected, or "daisy-chained" together, to operate simultaneously.